

REMARKS

Claims 38-39, 41-42, 47, 50-57, 131-133, 144-147 and 149-151 are pending with entry of this amendment. Claims 38-39, 42, 131, 133 and 144-147 are amended herein. These amendments introduce no new matter and support is replete throughout the specification. The amendment is made without prejudice and is not to be construed as abandonment of the previously claimed subject matter or agreement with any objection or rejection of record.

With respect to amended claims 38 and 144-147, support for a reference GAL4 protein encoded by a polynucleotide amplified from vector pCL1 using PCR primers set forth in SEQ ID NOs: 103 and 104 can be found in the specification at page 108.

Applicants submit that no new matter has been added to the application by way of the above Amendment. Accordingly, entry of the Amendment is respectfully requested.

The action rejected all of the claims under 35 U.S.C. §112. Applicants traverse all rejections and objections, to the extent that they are applied to the amended claims.

35 U.S.C. §112, ¶2

Claims 38-39, 41-42, 47, 50-57, 131-133, 144-147 and 149-151 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. To the extent that these rejections are applied to the amended claims, Applicants traverse.

The Action alleges that the recitation of “an analogue thereof” in claims 39, 41-42, 47, 50-57, 131-133 and 149-151 renders the claims indefinite. To facilitate prosecution, the claims are amended herein to remove this phrase from the claims. Accordingly, the rejections should be withdrawn.

The Action further alleges that the recitation of a recombinant mutant GAL4 protein that is “at least 90% identical to a GAL4 protein of *Saccharomyces cerevisiae*” in claims 38 and 144-147 renders the claims indefinite. The claims are amended herein to more clearly identify the reference *S. cerevisiae* GAL4 protein to which the claims are directed.

Applicants teach the amplification of a cDNA encoding the full-length wild-type *S. cerevisiae* GAL4 protein from vector pCL1 (a widely-used control vector containing the full-length GAL4 cDNA) using PCR primers with nucleotide sequences set forth in SEQ ID NOs: 103 and 104. *See* Specification at p. 108. The claims now recite the GAL4 protein encoded by this cDNA as the reference GAL4 protein. The amended claims clearly identify the reference GAL4 protein against which the amino acid sequence of the recombinant mutant GAL4 protein is compared and, accordingly, the rejections should be withdrawn.

35 U.S.C. §112, ¶1 – ENABLEMENT

Claims 39, 41-42, 47, 50-57, 131-133 and 149-151 were rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement. To the extent that these rejections are applied to the amended claims, Applicants traverse.

The Action alleges that the phrase “or analogue thereof” in reference to the unnatural amino acids p-acetyl-L-phenylalanine, p-amino-L-phenylalanine, or p-azido-L-phenylalanine broadens the scope of the claims beyond what is enabled by the specification. In order to facilitate prosecution, and without acquiescing or agreeing with any rejection of record, the phrase “or analogue thereof” has been removed from the claims as amended herein. Applicants note that the subject matter and scope of the amended claims is clearly enabled by the specification. Indeed, the specification provides detailed working examples of producing a recombinant protein comprising at least one p-acetyl-L-phenylalanine, p-amino-L-phenylalanine, or p-azido-L-phenylalanine unnatural amino acid comprising at least one post-translational modification. *See* Specification, Examples 1-6. Because the amended claims are clearly enabled by the specification, the rejections for alleged lack of enablement should be withdrawn.

35 U.S.C. §103

Claims 39, 41-42, 47, 50-57, and 131-133 were rejected under 35 U.S.C. §103 as obvious over Schultz et al. (US 20050186657 A1, now US 7,129,333 B2). Applicants traverse.

35 U.S.C. §103(c)(1) provides that “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Applicants confirm that the subject matter of the Schultz et al. ‘333 patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to the same entity. The invention claimed in the instant application was owned by The Scripps Research Institute (“Scripps”) or subject to an obligation of assignment to Scripps at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame No. 014977/0270). This assignment was recorded on August 5, 2004.

The Schultz ‘333 patent issued from USSN 11/094,676, a division of USSN 10/686,944 (the ‘944 application). The ‘944 application was owned by Scripps or subject to an obligation of assignment to Scripps at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame No. 015219/0968). This assignment was recorded on March 22, 2004. This assignment attaches to any continuation and/or divisional application that claims priority to the ‘944 application, e.g., USSN 11/094,676 from which the Schultz ‘333 patent was issued. Thus, the Schultz et al. ‘333 patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Scripps. Accordingly, the Schultz et al. patent cannot preclude patentability of the instant claims under §103(a), and the rejection should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the claims are deemed not to be in condition for allowance after consideration of this Response, a telephone interview with the Examiner is hereby requested. Please telephone the undersigned at (510) 337-7871 to schedule an interview.

Appl. No. 10/825,867
Amdt. Dated November 26, 2008
Reply to Office action of August 29, 2008

The Commissioner is hereby authorized to charge any additional fees associated with this paper or during the pendency of this application, or credit any overpayment, to Deposit Account No. 50-0893.

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Respectfully submitted,



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- 1) A transmittal sheet
- 2) A receipt indication postcard; and
- 3) PTOL-413A form (Applicant Initiated Interview Request Form)